

AMENDMENT UNDER 37 C.F.R. § 1.111  
Application No.: 10/608,196

Attorney Docket No.: Q76318

**AMENDMENTS TO THE DRAWINGS**

Annotated FIG. 1 is hereby submitted showing the second insulative sheet recited in claim 1.

Applicants also submit Replacement FIG. 2 wherein the incorrect designations "30" have been corrected to be designated "38".

Attachments: Annotated Sheet  
Replacement Sheet

**REMARKS**

**Status of the Application**

Claims 1-20 are the claims that have been examined in the application. Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-2, 5, 7-11 and 14-20 as best understood, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Onizuka (USP 6,390,830). Claims 1-2, 5, 7-8, 11 and 15-19 as best understood, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hattori et al. (USP 6,290,509). Claims 3-4, 6 and 12-13 as best understood, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Onizuka (USP 6,390,830). Claim 6 as best understood, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hattori et al. (USP 6,290,509). Claim 3 as best understood, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hattori et al. (USP 6,290,509) in view of Onizuka (USP 6,390,830).

By this Amendment, Applicants are amending claim 1, canceling claim 8 and adding claim 21.

**Drawings**

*The drawings are objected to under 37 C.F.R. § 1.83(a).*

The Examiner objects to the drawings for the following reasons: 1) the Examiner alleges that a reference number for the plurality of grooves recited in claim 15 should be included in the drawings; 2) the Examiner alleges that the arrows pointed to element 30 in FIGS. 1 and 2 appears to point at different elements; and 3) the Examiner requests that a drawing be submitted showing

a second insulative sheet disposed between the wiring member and the second wire group as recited in claims 3 and 4.

First, Applicants note to the Examiner that reference numbers  $32m_x$ ,  $32n_x$  correspond to the plurality of grooves in an exemplary embodiment of the invention.

Second, with regard to the alleged inconsistency in FIGS. 1 and 2, Applicants hereby submit a replacement FIG. 2 in order to cure the deficiency.

Third, page 9, lines 18-23 indicate that wiring members shown as reference numbers 38 and 54 in an exemplary embodiment of the instant invention also function as insulative members. Therefore, Applicants hereby submit an Annotated FIG. 1 indicating the location of the second insulative sheet.

**Claim Rejections - 35 U.S.C. § 112**

*Claims 1-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

On page 4 of the instant Office Action, the Examiner indicates that claims 1 and 4 appear to omit necessary structural connections. Specifically, the Examiner believes that, as seen in FIG. 1 of the instant invention, element 30 is responsible for holding both the first and second electric wires in their respective directions, not the wiring member 38, as it appears is claimed in claim 1. The Examiner believes that claim 1 should recite additional elements indicating the

relationship between the wiring member, and how it holds the first wire group and second wire group. With regard to claim 4, the Examiner asserts that similar elements should be recited.

On page 5 of the instant Office Action, the Examiner argues, similarly, that element 30, not element 38, in FIG. 1 holds the first wire group and second wire group, and thus the Examiner alleges that the claims are unclear in light of the specification and drawings.

Based on the Examiner's comments noted above, Applicants respectfully submit that the Examiner's rejection is unreasonable. The Examiner is failing to note that element 30 is a sub-element of larger element 38 (i.e. see claims 8 and 15-19). Therefore, Applicants submit that while the plurality of grooves actually holds the first wire group and second wire group, the plurality of grooves are a portion of the wiring member. Thus, claim 1 particularly points out and distinctly claims the subject matter Applicants regard as the invention. Applicants have also amended claim 8 to clarify the relationship between the plurality of grooves and the wiring member.

With regard to "b) relationship between a wiring member and the first wire group intersects the second wire group is missing for claim 1," and "c) relationship between a wiring member and holds both of the first electric wires and the second electric wires is missing for claim 4," Applicants submit that no further relationship needs to be recited. Claim 1 recites that the wiring member holds a first wire group in a first direction, and a second wire group is held in a second direction, which intersects the first direction (i.e. is not parallel). Claim 4 recites that the wiring member holds a first and second electric wires (regardless of direction). Thus, claims 1 and 4 need not recite any further relationship.

**Prior Art Rejections**

A. *Claims 1-2, 5, 7-11 and 14-20 as best understood, stand rejected under 35*

*U.S.C. § 102(b) as being anticipated by Onizuka (USP 6,390,830).*

Claim 1 recites, in part, “wherein the wiring member comprises a plurality of grooves each partly holding one of the first electric wires or one of the second electric wires.” The Examiner alleges that Onizuka discloses all of the elements of claim 1. Applicants respectfully disagree.

Onizuka discloses a bus bar connecting structure. However, Onizuka fails to disclose that a wiring member comprises a plurality of grooves each partly *holding one of the first electric wires or one of the second electric wires* as recited in claim 1. The Examiner alleges that the electric connection box 22 and 23 corresponds to the recited wiring member. However, electric connection box 22 and 23 do not show a plurality of grooves as recited in claim 1. Thus, claim 1 is patentable over the applied art. Claims 2, 5, 7-11 and 14-20 are patentable at least by virtue of their dependency from claim 1.

B. *Claims 1-2, 5, 7-8, 11 and 15-19 as best understood, stand rejected under 35*

*U.S.C. § 102(b) as being anticipated by Hattori et al. (USP 6,290,509).*

Claim 1 recites, in part, “wherein the wiring member comprises a plurality of grooves each partly holding one of the first electric wires or one of the second electric wires.” The

Examiner alleges that Hattori discloses all of the elements of claim 1. Applicants respectfully disagree.

Hattori discloses an electrical connector housing. The Examiner alleges that element 30 of Hattori corresponds to the recited wiring member. However, element 30 in Hattori is simply a crimping terminal for connecting a wire intersection part. This element cannot *hold* the first electric wires as recited in claim 1. Therefore, claim 1 is patentable over the applied art.

Claims 2, 5, 7-8, 11 and 15-19 are patentable at least by virtue of their dependency from claim 1.

*C. Claims 3-4, 6 and 12-13 as best understood, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Onizuka (USP 6,390,830).*

Claims 3 and 6 depend from claim 1. Because Onizuka fails to disclose all of the elements of claim 1, claims 3 and 6 are patentable at least by virtue of their dependency.

Claim 4 recites, in part, “a second insulative sheet, disposed between the wiring member and the second wire group.” The Examiner alleges that Onizuka discloses all of the features of claim 4, but fails to disclose a second insulative sheet. However, the Examiner alleges that because Onizuka discloses a first insulative sheet, and because it is well known in the electrical art to use an insulative sheet between the first wire group and the second wire group with a plurality of grooves, it would have been obvious to include a second insulative sheet because “it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art,” citing *St. Regis Paper Co. v. Bemis Co.* 193 USPQ8.

Applicants disagree with the Examiner for two reasons, 1) the Examiner has not provided a reference which discloses a second insulative sheet, and thus the applied prior art fails to disclose all of the elements of proposed amended claim 1, and 2) the Examiner is misapplying *St. Regis Paper Co.*

First, the Examiner has failed to provide a reference which discloses an insulative sheet being disposed between a second wire group and a wiring member. Onizuka strictly shows an insulative sheet being disposed between a pair of wire groups. See FIG. 4. of Onizuka. However, there is no second insulative sheet disclosed. See FIG. 2A-2C, which shows cross-sections of the wire groups and insulative sheet. Therefore, Onizuka cannot disclose all of the elements of claim 4.

Second, Applicants disagree with the Examiner because the Examiner is misapplying *St. Regis Paper Co.* In *St. Regis*, the Seventh Circuit found that the placement of one bag inside another to create a stronger bag would be obvious when both original bags read on a prior art bag. However, in the instant application, the second insulative sheet is not merely a duplication or repositioning of the first insulative sheet. Rather, the insulative sheet disclosed in Onizuka appears to correspond to the first insulative sheet recited in claim 1. However, an additional (second) insulative sheet is recited at a different location, with the second insulative sheet being different from the first insulative sheet. Therefore, because Onizuka fails to disclose all of the elements of claim 1, as amended, we would submit that claim 1 is patentable over the applied art.

Further, the Examiner alleges that it is well known in the art to use the insulated sheets disclosed in claim 1. Therefore, Applicants request that Examiner provide a reference disclosing the second insulated sheet as recited in claim 4.

Claims 12 and 13 are patentable at least by virtue of their dependency from claim 4.

*D. Claim 6 as best understood, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hattori et al. (USP 6,290,509).*

Claim 3 depends from claim 1. Because Hattori fails to disclose all of the elements of claim 1, claim 6 is patentable at least by virtue of its dependency.

*E. Claim 3 as best understood, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hattori et al. (USP 6,290,509) in view of Onizuka (USP 6,390,830).*

Claim 3 depends from claim 1. Because Hattori fails to disclose all of the elements of claim 1, and because Onizuka fails to cure the deficient disclosure of Hattori, claim 3 is patentable at least by virtue of its dependency from claim 1.

### **New Claim**

Applicants hereby add new claim 21, which depends from claim 4. Therefore, claim 21 is patentable at least by virtue of its dependency from claim 4.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the



AMENDMENT UNDER 37 C.F.R. § 1.111  
Application No.: 10/608,196

Attorney Docket No.: Q76318

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Dion R. Ferguson/

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

**65565**

CUSTOMER NUMBER

\_\_\_\_\_  
Dion R. Ferguson  
Registration No. 59,561

Date: January 25, 2008